

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

REMARKS

Applicants submit that the amendments presented herein are fully supported in the specification and the claims as originally filed and do not raise new matter. Further, the present amendments address some issues that are first raised in the outstanding Office Action, and which were not made earlier, because the first indication to Applicants that the present amendments would be needed was in that Office Action. In fact, the number of issues is reduced, since some of the claims are canceled herein. Therefore, entry of the present amendment is proper, and is respectfully requested.

In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Reply be entered for purposes of an Appeal. The Reply reduces the issues on appeal by reducing the number of claims (some claims are canceled) and by overcoming the rejections under 35 U.S.C. § 102. Thus, the issues on appeal would be reduced.

Claims 3-4, 13, 16 and 18-20 have been canceled without prejudice or disclaimer of the subject matter contained therein. Claim 11 was previously canceled. Also, claims 1, 8, 9, 15 and 17 have been amended. Claims 10 and 12 have been withdrawn. Thus, claims 1, 2, 5-10, 12, 14, 15 and 17 are pending in the present application.

No new matter has been added by way of these amendments, because each amendment is supported by the present specification. For example,

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

the amendment to claim 1 has support in the present specification at page 10, lines 5-19 and by canceled claim 16. With the amendment to claim 1 and the cancellation of claim 16, claims 15 and 17 were appropriately amended. Further, with the cancellation of claim 3, claims 8-9 were appropriately amended. These are clarifying and not narrowing amendments. For instance, by changing the dependency of these claims, Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

The changes to the present specification are obviously editorial in nature and do not add new matter.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(e)

Claims 1-10 and 13-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Isomura et al. '027 reference (U.S. Patent No. 6,437,027) (as stated in paragraph 5 of the Office Action).

The present invention is directed to a powdery dispersant for a hydraulic composition. Specifically, the present invention is characterized by the (1) powder, (2) an alkaline earth metal salt in

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

part of the claimed copolymer, (3) the mole (%) ratio between monomer (a) to (a) + (b), and (4) the average mole number range (45 to 150) of the C₂₋₄ oxyalkylene groups or oxystyrene groups of the copolymer (see claim 1). Other embodiments are also within the scope of the present invention (see the recited number of the C₂₋₄ oxyalkylene groups or oxystyrene groups as 70 to 115 in claim 3).

Isomura '027 is asserted to disclose the features of the present invention. However, Applicants respectfully submit that this reference is deficient in its disclosure regarding the present invention. Isomura '027 fails to disclose the combination of (1)-(4) as mentioned above. Thus, Applicants respectfully maintain their position that there is no disclosure in Isomura '027 of all features as instantly claimed. Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Isomura '027 reference cannot be a basis for a rejection under § 102(e). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Isomura '027 is overcome. Reconsideration and withdrawal are respectfully requested.

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

Issues Under 35 U.S.C. § 102(b)

Claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the JP '660 reference (Japanese Public. No. JP02000103660A; as stated in paragraph 6 of the Office Action).

Also, claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP '309 (Japanese Publication No. JP02000044309A; as stated in paragraph 7 of the Office Action).

Further, claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the JP '345 reference (JP409328345A; as stated in paragraph 8 of the Office Action).

In addition, claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP '315 (JP 2000086315; as stated in paragraph 9 of the Office Action).

Also, claim 9 stands rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over any one of the above recited Japanese patents, each one individually (as stated in paragraph 10 of the Office Action).

Finally, claims 1-10 and 13-20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the JP '145 reference (JP 20026145; as stated in paragraph 11 of the Office Action, which incorrectly refers to JP 20026146).

Applicants respectfully traverse, and reconsideration and withdrawal of all rejections are respectfully requested.

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

Distinctions over JP '660, JP '309, JP '345, JP '315 and JP '146

As mentioned, the present invention is characterized by the following claimed features: (1) powder, (2) alkaline earth metal salt in part of the claimed copolymer, (3) mole (%) ratio between monomer (a) to (a) + (b), and (4) average mole number range (45 to 150) of the C₂₋₄ oxyalkylene groups or oxystyrene groups of the copolymer. The selection of (2), (3) and (4) mentioned above makes it easier for the skilled artisan to obtain powder of the copolymer.

In fact, the claimed dispersant is unexpectedly improved in pressure resistance and humidity resistance (see pages 25-26 of the present specification), and even achieves a good balance between the pressure and humidity resistance (see the experimental results in Table 2 on page 28). Further, the presently claimed dispersant is unexpectedly better in pump transportability (see pages 26-28), which also has been experimentally confirmed. Therefore, the present invention can be used to obtain a hydraulic composition, just after kneading, having high flowability and suitable separation resistance, and will not hinder pumping of the composition.

Thus, Applicants respectfully submit that none of the cited references disclose all features and advantages as instantly claimed. There is no disclosure of the combination of (1)-(4) as instantly claimed. Further, none of the cited references of JP '660, JP '309, JP '345, JP '315 and JP '146 discloses the unexpected advantages of the

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

present invention, including the improved pressure resistance, pump transportability and resistance to humidity.

In addition, the (4) average mole number range (45 to 150) of the C₂-₄ oxyalkylene groups or oxystyrene groups of the copolymer is specified since a certain amount is mixed with the (2) an alkaline earth metal salt in part in order to obtain the (1) powder. There is no disclosure of the combination of these features in the cited references.

Thus, under *Verdegaal Bros.*, Applicants respectfully request the Examiner to reconsider and withdraw all rejections under § 102. Further, the rejection under § 103(a) is respectfully requested since a *prima facie* case of obviousness requires disclosure of all claimed features. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

Accordingly, Applicants respectfully request the Examiner to reconsider and to withdraw all rejections and allow the currently pending claims.

Unexpected Results Rebut Any Asserted Prima Facie Case of Obviousness

Applicants also request consideration of the unexpected results of the present invention, which rebut any asserted *prima facie* case of obviousness. As can be seen from Table 2 of the present specification (at page 28) as previously discussed, the present invention has unexpectedly achieved better resistance to pressure and humidity, and improved pump transportability. The unexpected results of the present

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

invention were not considered in the outstanding Office Action. Thus, Applicants respectfully request consideration of these patentable distinctions with regard to any and all of the cited references, and respectfully request withdrawal of these rejections.

PTO-326 Form

Applicants respectfully request clarification with regard to Box 8 on the PTOL-326 form, which is marked. Applicants respectfully submit that claims 13-20 fall within the elected subject matter. Applicants also note that some of these claims have been canceled herein.

Information Disclosure Statement of January 17, 2002

Applicants respectfully request an initialed copy of the PTO-1449 form which was submitted with the Information Disclosure Statement (IDS) on January 17, 2002. Applicants also submit that at least two of the five cited references have already been considered by the Examiner. If the Examiner has not received this IDS, Applicants respectfully request the Examiner to contact Applicants' representative.

Also, Japanese Application No. 11-292601 was one of the cited references in the IDS dated October 8, 2003. Though the Examiner has already provided initials next to each cited references, Applicants herein submit a full English translation of this Japanese reference for the Examiner's further consideration.

Application No. 09/994,651
Art Unit 1713
March 31, 2004
Reply to Office Action of December 22, 2003

Application Data Sheet

Enclosed herewith is an Application Data Sheet. This Application Data Sheet is being submitted in order to correct the spelling of the first-named inventor's last name. Specifically, the inventor's last name is Shiba, not Shibai. It is respectfully requested that this correction be made to the USPTO's records.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, or in an effort to advance prosecution, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 09/994,651

Art Unit 1713

March 31, 2004

Reply to Office Action of December 22, 2003

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

John W. Bailey, #32,881

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

JWB/ETP
0425-0866P

Attachments:

English translation of Japanese Application No. 11-292 601
Application Data Sheet